



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,784	03/18/2004	Koji Maruyama	249958US2S DIV	5074

22850 7590 08/21/2006

C. IRVIN MCCLELLAND
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

NGUYEN, HUY THANH

ART UNIT PAPER NUMBER

2621

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/802,784	MARUYAMA ET AL.	
	Examiner	Art Unit	
	HUY T. NGUYEN	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/18/04 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/233,027.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/29/05, 3/18/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. Claims 1 and 2 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/175,402 .

The difference between claims 1-2 of the present application and claims 1 and 2 of copending Application No. 10/175,402 is that claims 1 and 2 of copending Application No. 10/175,402 further recite a reproducing means for reproducing the video and audio from the medium . However, it is noted that eliminating a part is obvious to one of ordinary skill in the art. See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963). Therefore it would have been obvious to one of ordinary skill in the art to modify claims 1 and 2 of copending Application No. 10/175,402 by eliminating the reproducing means from claims 1 and 2 of copending Application No. 10/175,402 to produce claims 1 and 2 of the present application .

This is a provisional obviousness-type double patenting rejection.

2. Claims 1 -7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 -4 of U.S. Patent No. 6,668,135 in view of Taira et al (EP0737980 A2).

The difference between claims 1-7 of the present application and claims 1-4 of U.S. Patent No. 6,668,135 is that claims 1-4 of U.S. Patent No. 6,668,135 do not specifically teach that that the management information further include a start

Art Unit: 2621

address of the program chain that is being recited claims 1-7 of the present application . Taira teaches a recording/ reproducing apparatus for recording audio and video data in a file and management information in an area of a medium having means for generating a start address of a program chain (Figs. 71-72) . It would have been obvious to one of ordinary skill the art to modify claims 1 -4 of U.S. Patent No. 6,668,135 with Taira by providing the claims 1- 4 of U.S. Patent No. 6,668,135 with a generating means as taught by Taira for generating a start address of the program chain thereby accurately access a program chain and to produce claims 1-7 of the present application .

3. Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4 and 7-8 of U.S. Patent No. 6,560,407 in view of Taira et al (EP0737980 A2).

The difference between claims 1-7 of the present application and claims 1 and 4 of U.S. Patent No. 6,560,407 is that claims 1,4 and 7-8 of U.S. Patent No. 6,560,407 do not specifically teach that that the management information further include a start address of the program chain that is being recited claims 1-7 of the present application . Taira teaches a recording/ reproducing apparatus for recording audio and video data in a file and management information in an area of a medium having means for generating a start address of a program chain (Figs. 71-72) . It would have been obvious to one of ordinary skill the art to modify claims 1,4 and 7-8 of U.S. Patent No. 6,560,407 with Taira by providing the claims 1,4 and 7-8 of U.S. Patent

Art Unit: 2621

No. 6,560,407 with a generating means as taught by Taira for generating a start address of a program chain thereby accurately accessing the program chain and to produce claims 1-7 of the present application .

4. Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3 and 4-5 of U.S. Patent No. 6,385,389 in view of Taira et al (EP0737980 A2).

The difference between claims 1-7 of the present application and claims 3 and 4 of U.S. Patent No. 6,385,389 is that claims 1,3 and 4-5 of U.S. Patent No. 6,385,389 do not specifically teach that the management information further include a start address of the program chain that is being recited claims 1 -7 of the present application. Taira teaches a recording/ reproducing apparatus for recording audio and video data in a file and management information in an area of a medium having means for generating a start address of a program chain (Figs. 71-72) . It would have been obvious to one of ordinary skill in the art to modify claims 1,3 and 4 -5 of U.S. Patent No. 6,385,389 with Taira by providing the claims 1,3 and 4 -5 of U.S. Patent No. 6,385,389 with a generating means as taught by Taira for generating a start address of a program chain thereby accurately access the program chain and to produce claims 1-7 of the present application .

5. Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2,4 and 6 of U.S. Patent No. 6,674,959 in view of Taira et al (EP0737980 A2).

The difference between claims 1-7 of the present application and claims 1 and 2 of U.S. Patent No. 6,674,959 is that claims 1,2 and 4-6 of U.S. Patent No. 6,674,959 do not specifically teach that the management information further include a start address of the program chain that is being recited claims 1,2 and 4-6 of the present application. Taira teaches a recording/ reproducing apparatus for recording audio and video data in a file and management information in an area of a medium having means for generating a start address of a program chain (Figs. 71-72). It would have been obvious to one of ordinary skill in the art to modify claims 1 and 2 of U.S. Patent No. 6,674,959 with Taira by providing the claims 1,2 and 4-6 of U.S. Patent No. 6,674,959 with a generating means as taught by Taira for generating a start address of a program chain thereby accurately accessing the program chain and to produce claims 1-7 of the present application .

6. Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 3-4 of U.S. Patent No. 6,671,458 in view of Taira et al (EP0737980 A2).

The difference between claims 1-7 the present application and claims 1-2 and 3-4 of U.S. Patent No. of U.S. Patent No. 6,671,458 is that claims 1-2 and 3-4 of U.S. Patent No. 6,671,458 do not specifically teach that the management

information further include a start address of the program chain that is being recited claims 1-7 of the present application . Taira teaches a recording/ reproducing apparatus for recording audio and video data in a file and management information in an area of a medium having means for generating a start address of a program chain (Figs. 71-72) . It would have been obvious to one of ordinary skill the art to modify claims 1-2 and 3-4 of U.S. Patent No. 6,671,458 with Taira by providing the claims 1-2 and 3-4 of U.S. Patent No. 6,671,458 with a generating means as taught by Taira for generating a start address of a program chain thereby accurately accessing the program chain and to produce claims 1-7 of the present application .

7. Claim 7 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent No. 6,532,336 in view of Taira et al (EP0737980 A2).

The difference between claim 7 of the present application and claim 1 of U.S. Patent No. of U.S. Patent No. 6,532,336 is that claims1 of U.S. Patent No. 6,532,336 do not specifically teach that that the management information further include a start address of the program chain that is being recited claim 1 of the present application . Taira teaches a recording/ reproducing apparatus for recording audio and video data in a file and management information in an area of a medium having means for generating a start address of a program chain (Figs. 71-72) . It would have been obvious to one of ordinary skill the art to modify claim 1 of U.S. Patent No. 6,532,336 with Taira by providing the claim 1 of U.S. Patent No. 6,532,336 with a

generating means as taught by Taira for generating a start address of a program chain thereby accurately accessing the program chain and to produce claim 1 of the present application .

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 7 directs to information stored on a medium. Since the information does not provide any functional interrelationship to the medium to control the medium or to access information on the medium, or impart to any structural software or hardware components to provide certain function that is processed by a computer, the information stored on the medium does not make them statutory. See MPEP 2100.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.N

HUYNH NGUYEN
PRIMARY EXAMINER